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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,620	05/08/2007	Jakob Maier Jun	4100.P0423US	9965
23474 7590 08/17/2009 FLYNN THIEL BOUTELL & TANIS, P.C. 2026 RAMBLING ROAD KALAMAZOO, MI 49008-1631				
EXAMINER				
HAYES, KRISTEN C				
ART UNIT		PAPER NUMBER		
3643				
MAIL DATE		DELIVERY MODE		
08/17/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/587,620

Applicant(s)

MAIER JUN ET AL.

Examiner

KRISTEN C. HAYES

Art Unit

3643

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 56-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 55-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 May 2009 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date 20090706
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 07/06/2009 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

Drawings

2. In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 26, 11, 23, 18, 111, 323, 326, 318, 311, 436, 437, 450, 426, 521, 511 and 611. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet"

pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The substitute specification filed 05/19/2009 has not been entered because it does not conform to 37 CFR 1.125(b) and (c) because: A substitute specification submitted under this section must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown pursuant to this paragraph.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 56-66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
8. Claim 56 recites the limitation "the inner side" in line 12. There is insufficient antecedent basis for this limitation in the claim.
9. Claim 61 recites the limitation "the surface of the component in question" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim. Also, the wording of "the component in question" is broad and could include any component of the device, which makes the limitation indefinite.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 56 and 57 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldberg et al US 4,610,220.
12. Regarding claim 56, Goldberg discloses a teat rubber (Goldberg, Figures 4, 5) comprising a head part (14', 114) having a sealing lip (30', 156) that forms an insertion opening, a holding edge (122) (Goldberg, Figure 4), a milking cup sleeve (15), a suction connecting piece (near 34', near 168) connected to the head part as well as a planar teat bearing section (50, 144) which is formed on the sealing lip, a part of the insertion opening conically tapering (near 30', near 156)(Goldberg, Figures 4, 5) towards the inner side of the teat rubber in such a way that the inner annular fold (as best understood) located on the base of the teat cannot come into

contact with the teat rubber and that pressure cannot be applied thereto; characterized in that when seen in a cross sectional view, a conically tapering surface (near 52, near 146) of the conically tapering insertion opening is convex and that a transition between the conically tapering surface and the planar teat bearing section and the udder bearing surface (at 52, at 142, 146) is implemented in a hingelike manner (Goldberg, column 4: lines 33-35, column 6: lines 29-32) (indentations at 30', 52, 156, 154).

13. Regarding claim 57, Goldberg further discloses the hingelike transition comprising a portion of reduced material thickness (Goldberg, column 4: lines 33-35, column 6: lines 29-32) and an indentation (30', 52, 156, 154).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 58-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg et al US 4,610,220 in view of Silver et al US 2002/0198489.

16. Regarding claim 58, Goldberg discloses the device of claim 56 but does not disclose a cushion portion of the teat bearing section. Silver teaches an entire teat receiving portion having cushioned surfaces planar teat bearing sections (735, 740) (Silver, ¶0160). It would have been obvious to one of ordinary skill in the art at the time of the invention to cushion the entire planar teat bearing section of Goldberg as to increase the comfort of the device for the animal.

17. Regarding claims 59, 60 and 62, Goldberg in view of Silver discloses the device of claim 43 and further discloses an entire teat bearing portion cushioned surface consisting of foam

(Silver, ¶0160). Not disclosed is the foam being a foamed silicone elastomer. However, foamed silicone elastomer is well known in the art. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. It would have been obvious to one of ordinary skill in the art at the time of the invention to make the foam a foamed silicone elastomer as to maintain the flexibility of the teat rubber while providing cushion.

18. Regarding claim 61, Goldberg in view of Silver discloses a foamed elastomer. The limitation of the foamed elastomer being sprayed onto a surface is considered a product-by-process limitation. It has been held that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966.

19. Regarding claim 63, Goldberg in view of Silver further discloses the cushioned surfaces being cushioned pockets (Silver, 742, 738, 740).

20. Regarding claim 64, Goldberg in view of Silver further discloses the cushioned surface being a fluid-filled pad (Silver, 740).

21. Regarding claims 65 and 66, Goldberg in view of Silver further discloses the fluid-filled pad being a replaceable insert (Silver, 340) (In that the fluid-filled pad is a separate element. The area in which the pad is positioned is openable, as the wall elements rest on each other and are therefore not permanently connected (Silver, ¶0159: lines 7-9)).

Response to Arguments

22. Applicant's arguments filed 05/19/2009 have been fully considered but they are not persuasive.
23. The material thickness difference of Goldberg is seen as forming a hinge, as per applicant's invention.

Conclusion

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTEN C. HAYES whose telephone number is (571)270-3093. The examiner can normally be reached on Monday-Thursday, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on (571)272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KCH
13 August 2009

Peter Poon
Examiner
Art Unit 3643

/Peter M. Poon/
Supervisory Patent Examiner, Art Unit 3643